

## REMARKS

### Summary of the Office Action

Claims 1-3, 8, 10, 13, 16, and 21-24 are pending in this application.

Claims 1-3, 8 and 21 have been rejected as obvious over U.S. Patent No. 6,120,534 to Ruiz (“Ruiz”) in view of European Patent No. 0 779 062 to Glastra et al. (*Glastra*).

Claims 1-3, 8, 13, 16, and 23-24 have been rejected as obvious over *Glastra* in view of German Patent No. 195 09 464 to Jäger (“Jäger”).

Claim 10 has been rejected as obvious over *Glastra* in view of Jäger and further in view of U.S. Patent No. 5,695,498 to Tower (“Tower”).

Claim 22 has been rejected as obvious over *Glastra* in view of Jäger and further in view of U.S. Patent No. 5,843,116 to Crocker (“Crocker”).

### Response to the Office Action

Claims 1-3, 8, 10, 13, 16 and 21-24 are pending in the application. Claims 1 has been amended to import the limitations of claim 13, and claim 13 has been canceled. Therefore, upon entry of the present amendment, claims 1-3, 8, 10, 16 and 21-24 will be subject to examination.

The Examiner’s rejection of the pending claims are based on alleged obviousness in view of the cited references. A prima facie case of obviousness requires: (1) a reason to combine; (2) a reasonable expectation of success; and (3) a teaching or suggestion of all claim limitations in the prior art. *Brown & Williamson Tobacco Corp. v. Philip Morris*, 229 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Regal*, 526 F.2d 1399, 1403 (C.C.P.A. 1975).

The rejection of independent claim 1 of and the claims depending thereon is respectfully traversed at least for the reasons detailed in the following sections.

#### **A. The Rejection of Claims 1-3, 8 and 21 over Ruiz in view of Glastra**

The rejection of claims 1-3, 8 and 21 over Ruiz in view of *Glastra* is traversed because Ruiz and *Glastra*, alone or in combination, do not teach all the elements of independent claim 1 and of the claims depending therefrom, and because there is no reason for a person skilled in the art to combine the cited references, indicating that the Examiner’s rejection is based on

impermissible hindsight.

*Ruiz* teaches a stent with a ring-like section of reduced diameter obtained by expanding two balloons at opposite ends of the stent. Therefore, *Ruiz* does not teach expansion with a single balloon, as the Examiner has admitted. *Glastra* instead teaches stent expansion with a single balloon, but does not teach using a balloon having a stiffening element. Therefore, the combination of *Ruiz* and *Glastra* do not teach all the limitations of independent claim 1 or of the claims depending therefrom.

Applicant also notes that *Ruiz* expressly requires that stent expansion be performed with two opposing balloons, contrary to the teachings of *Glastra*, which had been published before *Ruiz*. Therefore, *Ruiz* elected not to employ the expansion method of *Glastra*.

Applicant further notes that one of the problems solved by Applicant's invention is blood turbulence as blood exits the stent section of reduced diameter (see, e.g. paragraph [0008] of the published specification), while the design of *Ruiz*, lobed and with sharply changing cross-section, is prone to turbulence. *Glastra*, on the other hand, teaches to a stent that supports a vessel in the proximity of a tumor, and is not concerned with blood turbulence, which is not even mentioned by *Glastra*. Therefore, there is no reason why a person of ordinary skilled in the art would have removed a main design element of *Ruiz* (which was developed after *Glastra*) and introduced in its place a design feature of *Glastra*, when neither reference – particularly *Glastra* - addresses blood turbulence. For the foregoing reasons, Applicant submits that the proposed combination of *Ruiz* and *Glastra*, even if such a combination were possible, can be based only on impermissible hindsight by the Examiner.

**B. The Rejection of Claims 1-3, 8, 13, 16, and 23-24 over *Glastra* in view of *Jäger***

The rejection of claims 1-3, 8, 13, 16, and 23-24 over *Ruiz* in view of *Glastra* is respectfully traversed because *Ruiz* and *Glastra*, alone or in combination, do not teach all the elements of independent claim 1 and of the claims depending therefrom

*Glastra* has been discussed above. The Examiner has admitted that *Glastra* does not teach the use of a stiffening element to form the essentially tubular segment of reduced expandability. The Examiner has characterized *Jäger* as teaching a stiffening element for forming a reduced expandable section. *Jäger*, however, teaches that “Die Einshnürung 5 kann beispielweise von einem eng um den Schlauch gewickelten Draht oder einer Federklammer fixiert sein,” which Applicant understands to mean that “the chokepoint 5 can for example be

stabilized by a wire wound around the chokepoint 5 or by a spring clip.” Therefore, *Jäger* does not teach the forming of the stent by stabilizing the central portion of the balloon, but by pre-stabilizing the central portion of the stent. In fact, Applicant could find no reference to expansion balloons in *Jäger*.

Applicant notes that such a deficiency in *Jäger* had been discussed in the response to the Office Action of November 11, 2006 and has not been rebutted by the Examiner.

Based on the foregoing, independent claim 1 is not amended either in view of the combinations of *Ruiz* and *Glastra*, or of *Glastra* and *Jäger*. Therefore, none of the claims depending from claim 1, including claims 10 and 22, are obvious in view of the cited references.

### **Conclusion**

In view of the foregoing amendment and comments, Applicant respectfully submits that the application is now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

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Respectfully submitted,

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